

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Eric Neil Miller et al.

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For: ONLINE DONATION MANAGEMENT
SYSTEM

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REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. §41.41(a)(1), this Reply Brief is filed within two months of the Examiner's Answer dated June 28, 2007 (hereinafter the "Examiner's Answer").

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STATUS OF CLAIMS

Claims 1-17 were canceled.

Claims 18-26 are pending, were finally rejected, and are being appealed.

Claims 18, 24 and 26 are independent claims.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 18-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over (1) www.redcross.org (January 25, 1999) ("Redcross") in view of (2) U.S. Patent No. 6,029,141 to Bezos et al. (Bezos), and (3) Hopkins (Article "Charity Auctions And Tax Law", Nov. 1994).

ARGUMENT

Reply To Examiner's Answer.

(I) Independent Method Claims 18 and 24.

(A) Discussion Of The Prior Art. Redcross simply discloses a stand-alone web site – where the donor starts and finishes a giving opportunity at a single web site, Hopkins simply discloses tax treatment of charitable donations, and Bezos simply discloses hyperlinking two business entities in a particular manner to accomplish a particular business purpose - a specialized consumer referral and commission payment method.

If the term “donor” is assumed *arguendo* to be equivalent to the Bezos term “customer”, the term “charitable organization” is assumed *arguendo* to be equivalent to the Bezos term “associate”, and the term “independent entity” is assumed *arguendo* to be equivalent to the Bezos term “merchant”, then combining the above cited art, without benefit of the teaching of the present application, results in a method of operation as follows:

(1) a donor wants to make a donation to a charitable organization and goes to the web site of that charitable organization;

(2) the charitable organization's web site presents specialized information, generated by the charitable organization, for projects of an independent entity;

(3) the donor reviews that specialized information for the various projects of the independent entity;

(4) at the charitable organization's web site, after reviewing that specialized information for the projects of the independent entity, the donor then selects a desired project of the independent entity to support;

(5) the referred donor is then hyperlinked to the independent entity's web site;

(6) the referred donor reviews other information, provided by the independent entity about the selected project of the independent entity;

(7) the referred donor confirms (e.g., “clicks on”), at the independent entity's web site, the selected project of the independent entity; and

(8) the donation is closed and handled by the independent entity's web site for the selected project of the independent entity.

This is not, however, the invention of claims 18 and 24. Numerous and substantial modifications are required to change from the above combination method to the method of

claims 18 and 24. This is perhaps better seen by the table below which compares the above combination method to claims 18 and 24.

Bezors in combination with Redcross and Hopkins	Summary of steps of Claim 18
A donor (the customer of Bezors) wants to make a donation to a charitable organization (buy a product from the associate of Bezors) and goes to the web site of that charitable organization;	(a) The prospective donor goes to the Charitable Organization's web site;
the charitable organization's web site presents specialized information, generated by the charitable organization, for projects <u>of the independent entity</u> (the merchant of Bezors);	---
the donor reviews that specialized information for the various projects <u>offered by the independent entity</u> ;	---
at the charitable organization's web site, and <u>after reviewing</u> that specialized information for the independent entity's <u>project</u> , the donor selects (e.g., "clicks on") a desired project of the independent entity to support;	---
---	(a) The prospective donor indicates a general interest in making some kind contribution <u>to that Charitable Organization</u> (such as by clicking on a link to the web site of an independent, second entity – the "Second" web site);
the referred donor is then transferred (hyperlinked) to the independent entity's web site,	(b) The prospective donor is then transferred (hyperlinked) to the Second web site;

Bezos in combination with Redcross and Hopkins	Summary of steps of Claim 18
along with an indication of the selected project of <u>the independent entity</u> , the donor identity, and the charitable organization's identity;	---
the independent entity's web site presents to the referred donor other information, <u>generated by the independent entity</u> , for the pre-selected project of <u>the independent entity</u> ;	---
---	(c), (e), (f) The Second web site provides, to the prospective donor, the contribution options and information, hosted on the Second web site, for those contribution options which are offered for or sponsored by that Charitable Organization;
the referred donor confirms (e.g., "clicks on"), at the independent entity's web site, the selected project of <u>the independent entity</u> ; and	---
---	(d), (g), (h) The prospective donor selects (e.g., "clicks on") a desired contribution option <u>for that Charitable Organization</u> at the <u>Second</u> web site (<u>NOT</u> a contribution option for the independent second entity); and
the donation is closed and handled by the independent entity's web site for the selected project of <u>the independent entity</u> .	---
---	(i), (j), (k), (l) The donor makes the desired contribution <u>to the Charitable Organization</u> via the Second web site (not to the independent second entity).

From the above, it is readily seen that the services and information provided by the associate and the charitable organization are very different between the combination of Redcross/Bezos and claims 18 and 24. Likewise, the services and information provided by the merchant and the independent entity are very different between the combination of Redcross/Bezos and claims 18 and 24. In addition, the result (whose product/project is bought/supported) is very different between Redcross/Bezos and claims 18 and 24. Even the underlying basic motivation behind the very first step - going to the Associate's/Charitable Organization's web site - is, however, radically different. Claims 18 and 24 specify that the donor wants to make a donation to the charitable organization whereas, in Bezos, the customer's motivation is not to donate anything to anyone, but is to buy a product. Further, the second step is not in the same order or position, relative to the other steps, when comparing the combination of Redcross/Bezos to claims 18 and 24. Furthermore, the steps in the Bezos/Redcross combination are very different from the steps in claims 18 and 24. There are only two steps that they may seem to have in common: (1) the customer/donor going to the Associate's/Charitable Organization's web site; and (2) the customer/donor then being transferred to another web site. Thus, there is a serious question of whether even these steps are present in the combination of Bezos/Redcross.

The other steps are very different and, as mentioned above, the parties actually sponsoring the products/projects are even different entities: in Bezos the Associate is referring the customer to the Merchant to purchase the Merchant's product; in contrast, in claims 18 and 24 the Charitable Organization is referring the donor to the other organization's web site so that the donor can support the Charitable Organization's project, NOT so that the donor can support the other organization's project.

Note also that, in Bezos, the customer ends up buying the product from a different entity (the Merchant) than the customer originally went to (the Associate) for the product, which product is probably made by a third party. In claims 18 and 24, even though the donor is now at the second web site, the donor is still making the contribution for the same entity (Charitable Organization) that the donor originally intended.

Numerous and substantial modifications are required in order to change the combination of Redcross/Bezos into the invention of claims 18 and 24.

1. First, one must decide that the Merchant is not going to be selling its own (or a third party's) products, the products to be sold will now have to be the Associate's products instead of the Merchant's products.

2. Second, the specialized information on the Associate's web site for the Merchant's products must be removed because, according to modification 1 above, there are no Merchant's products being sold – the products being sold will have to be those of the Associate.

3. Third, the hyperlinks from the Associate's web site to the various Merchant's products on the Merchant's web site must be removed because, again according to modification 1, there are no Merchant's products being sold.

4. Fourth, a hyperlink must be inserted which allows the customer to indicate a general interest in making some kind of purchase from that particular Associate, rather than purchasing a specific item from the Merchant.

5. When the customer is transferred (hyperlinked) from the Associate's web site to the Merchant's web site, an identification of the product selected cannot be sent because, according to modification 1, there was no product which could have been selected. Also, a customer identification or an Associate identification cannot be sent because, as there is no Merchant product which can be purchased, it really doesn't matter whether the customer arrived at the Merchant's web site directly or through an Associate.

6. Information on the Merchant's products is not present in response to the hyperlink because, according to modification 1, there are no Merchant's products. Rather, only information on products offered by the Associate is presented.

7. The customer cannot select a Merchant's product because, according to modification 1, there are no Merchant's products. Rather, the customer can only select a product offered by the Associate.

8. The customer cannot purchase a Merchant's product because, according to modification 1, there are no Merchant's products. Rather, the customer can only purchase, at the Merchant's web site, a product offered by the Associate.

As seen from the above, numerous and substantial modifications of Redcross/Bezors are required in order to arrive at claims 18 and 24 . Further, as shown above, even the intent of the donor in going to the first web site is very different from the intent of the customer in Bezors.

(B) The Examiner's Answer. The examiner admits that Redcross does not anticipate claims 18 and 24 but argues that Redcross and Bezos (with Hopkins) make claims 18 and 24 obvious.

The examiner argues that Redcross discloses steps (a) and (c)-(l). (Examiner's Answer, pages 5 and 6.) In doing so, the examiner completely ignores at least two significant distinctions. One significant distinction is that Redcross is a stand-alone web site, that is, all events occur at the first, single web site, but the claims requires a first event to occur at a first web site, a transition to a second web site, and the occurrence of the remaining events to be at the second web site. Thus, although Redcross discloses step (a), it does not disclose steps (b)-(l). Furthermore, the hyperlinking step (b) from the first web site to the second web site, and the relative position of the hyperlinking step (b) with respect to the other steps (a) and (c)-(l), are important requirements that cannot be simply ignored.

Another significant distinction underlying claims 18 and 24 is the motivation of the donor. In claims 18 and 24, an expressed limitation is that the donor intends to make a monetary contribution to the charitable organization. The selection of and donation to a project of the charitable organization is merely the way that the donor accomplishes the donor's intent and the project selected is one which was offered by the charitable organization. In contrast, in Bezos, the customer is not interested in making a donation of any kind to anyone, but is concerned with buying a particular product. Generally, the customer is merely concerned that the product purchased be the desired product; the customer has no particular concern whether the purchase actually benefits the associate, the merchant, or anyone else. For example, if one goes to a web site to buy a new song, the buyer generally does not care which organization or web site gets the money, the buyer just wants the song. In contrast, however, in claims 18 and 24, the donor's intent is required to be to make a donation to the charitable organization and the project is selected to achieve that purpose; but in Bezos, the customer's intent is to buy a particular product, with no concern as to who benefits from the sale. Thus, even the basic starting points of claims 18 and 24 are radically different from the starting point of Bezos.

The examiner also argues that Bezos discloses "allowing the 1st business entity to effectively become an online retailer immediately by simply enrolling and setting up a web site if it does not have sufficient resources to effectively handle online tasks such as processing online orders, shopping products, collecting payment, and providing customer service, etc." (emphasis

added.) (Examiner's Answer, page 13, bottom of second paragraph.) From this characterization of Bezos by the examiner, all that would be needed to achieve the business purpose of Bezos is for the 1st business entity (the associate) to have a web page with a link to the 2nd business entity (the merchant). This, however, completely mischaracterizes Bezos.

Bezos discloses a particular motivation and method of doing business – two entities want to sell the same products. A first (merchant) entity can provide certain information on the products and close a sale but, to maximize sales of a product, specialized information is needed for that product, and the merchant does not want to expend the resources to provide that specialized information. A second entity (associate) is particularly suited to provide the specialized information, but does not want to expend the resources necessary to close the sale. In order for the merchant to maximize sales of the product, the merchant allows the associate to entice the customer to purchase the product of the merchant by the associate providing that specialized information and, once the customer decides to buy the product, the customer is then transferred to the merchant to close the sale. Both the associate and the merchant provide some information and services, the customer gets the desired product without any concern or intent as to who benefits from the sale, and both the merchant and the associate benefit from the sales of the product. In contrast, simply enrolling and setting up a web site with a hyperlink from the associate to the merchant is not the business model contemplated or fairly suggested by Bezos. What business motivation would the merchant have to pay the associate for doing nothing but “simply enrolling and setting up a web site” with a hyperlink? None. The business motivation arises from the associate doing something to provoke a sale, i.e., providing the specialized information to entice the customer to buy the product and then hyperlinking the customer to the merchant. Consider, for example, that the U.S. Patent & Trademark Office sells certified copies of file histories and assignments. Many law firm web sites have hyperlinks to the USPTO web site. Would the USPTO be inclined to give a referral fee to a law firm for doing nothing other than “simply enrolling and setting up a web site” with a hyperlink from the law firm's web site to the USPTO web site? Clearly, there is no motivation, especially from the viewpoint of a businessperson/merchant, to give a referral fee to another entity for “simply enrolling and setting up a web site”.

Also, another major difference is that in Bezos the 2nd web site (merchant) is selling its own products (actually, probably the products of a third party), not products of the 1st web site

(associate). In contrast, the claims require that the 2nd web site promote projects sponsored by the 1st web site. Bezos does not fairly suggest or disclose that the associate should refer the customer to the merchant to support the associate's projects. Bezos only fairly suggests and discloses that the associate should refer the customer to the merchant to purchase the products offered by the merchant.

It should not be overlooked that Bezos actually discloses that the 2nd business entity (the merchant) is complete in and of itself with respect to the sale of products; that is, the customer can, if desired, go directly to the merchant web site, obtain certain information about the product, and purchase the product directly from the merchant without having had any interaction with the associate. Bezos appreciates that smaller business entities (1st business entity – the associate) may not want to invest the resources necessary to provide a full service web site, but that these 1st business entities may provide additional sources of sales for the merchant. Bezos thus discloses that the 1st business entity (associate) provides a web site with specialized information on products and, only after the customer has decided to buy a particular product, is the customer then transferred to the 2nd web site (merchant) to complete the sale. Bezos thus discloses that the associate provides specialized information about products which entices the customer to buy a selected product, at which point the customer is transferred to the merchant to complete the sale, and the associate is credited with some amount for enticing the customer to purchase the product. Bezos neither suggests nor discloses, nor provides any business motivation for, crediting the associate for “simply enrolling and setting up a web site” with a hyperlink.

Note also that the products sold by the 2nd business entity (merchant) are the merchant's products, not the associate's (1st business entity) products; Bezos neither suggests nor discloses that the associate should simply provide a link to the merchant's web site to allow the merchant to complete purchases of the associate's products.

In order to accomplish the referral and commission business purpose, Bezos requires that the customer go to the 1st web site (associate), to view the specialized information provided by the 1st web site for products which are available on the 2nd web site (merchant), and to select - at the associate's web site - one of the merchant's products. After selecting one of the merchant's products, the customer is then referred by being hyperlinked to the merchant's web site where the customer can complete the purchase of the merchant's product previously selected at the associate's web site.

In contrast, and very briefly stated, claims 18 and 24 require that the donor go to the 1st web site (charitable organization) and then be hyperlinked to a 2nd web site whereupon, once the donor is at the 2nd web site, the donor can then view the projects of that charitable organization (1st web site), select a particular project of that charitable organization, and make a donation to that charitable organization.

As shown above, there are numerous, substantial differences in the steps of the claims when compared with the steps in the method of Bezos / Redcross. The examiner attempts to summarily dismiss these differences by simply stating that Bezos is only cited for “the teachings of (1) hyperlinking the customer (donor), who accesses the 1st web site with intention to do business with the 1st entity, to a 2nd web site serving like a host in the backend to allow the customer to carry out the same business activities as if the customer was on the 1st website.” (Examiner’s Answer, page 14, last paragraph.) The approach suggested by the examiner completely disregards the teaching of Bezos. Bezos is a business method of increasing sales by adding additional salespersons (associates) and teaches that the associate should provide information about the merchant’s product which entices the customer to buy the merchant’s product. Simply providing a hyperlink does not accomplish Bezos’ business purpose. To the extent that Bezos may suggest simply providing a hyperlink, the associate gets no commission for that referral, and the product sold is still the merchant’s product. Business considerations therefore dictate that Bezos cannot be construed so broadly, Bezos discloses a particular solution to a particular business setting and problem – how to increase sales by referral and commission.

The illustrated differences clearly point out that Bezos and Redcross do not lend themselves to direct substitution, or even combination, to arrive at claims 18 and 24; numerous and substantial modifications are required to a combination of Bezos and Redcross in order to arrive at claims 18 and 24.

The number and nature of these illustrated differences, furthermore, point out the non-obviousness of modifying the combination of Bezos and Redcross. If only one step were required to be modified, an argument for obviousness might be tenable; when two steps are required to be modified, the argument becomes less tenable; when three steps are required to be modified, the argument is rapidly becoming untenable. As more and more steps of the combination need to be modified there comes a point when there is so little left of the original combination that an assertion of obviousness becomes completely untenable.

That point has surely been passed in the instant case because, as shown below, numerous steps of the combination must be substantially modified to arrive at the method of claims 18 and 24. The nature and number of those differences and modifications clearly render the claims 18 and 24 patentable over the cited art, singly and in combination. The examiner's summary dismissal of these differences is arbitrary, is not justified, and is not supported by the clear facts in this case.

(II) Independent Method Claim 26.

Independent method claim 26 has limitations which are not present in independent method claims 18 and 24. Those limitations were neither considered nor addressed by the examiner in the Final Office Action or the Advisory Office Action, even after those limitations were specifically pointed out by the applicant in the response to the first Office Action and in the Rule 116 response. Those limitations were again pointed out by the applicant in the appeal brief and the examiner has now finally acknowledged their existence. The examiner first attempts to dismiss those limitations by stating that "steps (b)-(f) ... merely deal with the first entity providing the second entity (central Internet website) information about its business activities with it's customer ... so that these same business activities can be carried out on the 2nd website through the linking step, these are fairly taught in Bezos..." (emphasis added.) (Examiner's Answer, pages 11-12.) Bezos, however, fairly teaches no such arrangement.

Bezos teaches that the associate web site provides at least some specialized information about the products on the merchant's web site, that the merchant also provides at least some information about the merchant's own products, that after the customer has made a selection at the associate's web site of a merchant's product to buy the customer is then hyperlinked to the merchant's web site where the customer can purchase the merchant's product. In contrast, claim 26 requires the charitable organization web site to upload information about the charitable organization's (1st) project to the central web site, to hyperlink the donor to the central web site, where the donor can then support the charitable organization's project, not the merchant's products. In other words, Bezos teaches that the associate provides some information and hyperlinks a customer to the merchant's web site for the customer to buy a selected merchant's product. Bezos does not fairly teach that the associate provides information on its own products

to the merchant's web site, and then hyperlinks the customer to the merchant's web site to buy the associate's products.

The examiner then asserts, alternatively, that these steps "are inherently included in the teachings of www.redcross.org/BEZOS et al when combining www.redcross.org/BEZOS et al together..." (emphasis added.) (Examiner's Answer, top of page 12.) These steps cannot be inherently included because, as shown above, numerous modifications are required on the combination of Redcross/Bezoz in order to arrive at claims 18 and 24. Further, as shown above, Bezoz neither fairly teaches nor suggests that the associate should provide a hyperlink to the merchant's web site in order for the customer to buy the associate's products.

(III) Discussion of Case Authority Cited By The Examiner.

In the Examiner's Answer, beginning on page 12, the examiner states "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)." These cases are inapposite.

In Keller, one set of references (Keller and Berkovits patents) taught cardiac pacers using R-C timer circuits, and another reference (Walsh article) taught the use of digital timers instead of R-C timers. Applicant argued that Walsh did not suggest use of a digital timer in a cardiac pacer, but the court held that the direct substitution of one known timer (a modern digital timer) in place of another timer (an analog R-C timer) was well within the capabilities of one of ordinary skill in the art, provided no unexpected results, and therefore was obvious.

Similarly, in Merck, the references disclosed imipramine for treatment of depression, that amitriptyline was related to imipramine by isosterism, and that compounds related by isosterism were expected to have similar properties. Applicant argued that the Petersen reference taught away from the appellant's invention and therefore did not suggest use of a amitriptyline for treatment of depression, but the court held that the direct substitution of one known compound (amitriptyline) for its known isosteric relative (imipramine) for treatment of depression was well within the capabilities of one of ordinary skill in the art, provided no unexpected results, and therefore was obvious.

Thus, in the cited cases the application of the prior art to the claimed invention only involved a straightforward, direct substitution of one known component for another, related or equivalent, known component.

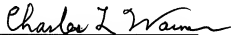
In the present appeal, however, the facts are very different. Redcross discloses a stand-alone web site, Hopkins discloses tax treatment of charities, and Bezos discloses a particular method of hyperlinking two entities for a particular business increase, referral and commission purpose. Bezos actually teaches that the merchant web site could be and is a stand-alone web site, but that there is an advantage to a particular business arrangement with other, presumably non-stand-alone, web sites. Directly combining Redcross with Bezos (similar to the direct substitution in Keller and Merck) would simply result in the merchant of Bezos having a web site which can be a stand-alone web site, but offering charitable items for sale instead of commercial items which combination is, actually, just the Redcross web site itself. Alternatively, directly combining Redcross with Bezos another way would simply result in two stand-alone web sites (the associate and the merchant) having a hyperlink to each other. Modifying the combination of Redcross and Bezos to arrive at the invention of claims 18 and 24 requires a complete reconstruction of the business relationship of Bezos, the point at which the hyperlinking occurs relative to the other steps, and modification of the steps involved before and after the hyperlinking. In other words, the direct substitution of components that was present in Keller and Merck is not present in the instant case. Thus, the combination of Redcross, Bezos, and Hopkins, even when considered under Keller and Merck, do not make the claims 18 and 24 obvious.

CONCLUSION

The examiner has thus failed to meet his burden by showing any motivation, or reason, or suggestion as to why or how Bezos should be modified to arrive at the claims. Further, as shown above, combining Redcross and Bezos results in a combination which requires numerous and substantial modifications to arrive at the claimed invention. Also, when viewed as a whole, Bezos actually teaches away from the suggestions asserted by the examiner and the combination suggested by the examiner would be contrary to the motivation and teachings of Bezos.

Applicants respectfully submit that modification of the combination of Redcross and Bezos, as urged by the examiner, would not have been obvious to the person of ordinary skill in the art from the prior art in view of the teachings of the prior art, and without the benefit of the present application. Therefore, the examiner should be reversed and the claims allowed.

Respectfully submitted,
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